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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES and PAUL W. BUENGER

Appeal 2009-005673
Application 10/821,146
Technology Center 2100

Before: JEAN R. HOMERE, THU A. DANG, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134(a) (2002) from a final rejection of claims 1 and 3-20. Claim 2 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

We AFFIRM-IN-PART.

Introduction

According to Appellants, the invention is a system and method for detecting incorrect versions of files via computer software. The invention issues a warning if a file to be used is an older version and issues the location of a newer version of the file. (Abstract and Spec. 1, § Field).

STATEMENT OF CASE

Exemplary Claims

Claims 1 and 5 are exemplary claims and are reproduced below:

1. A method comprising:

finding a first file in a first directory specified in a classpath;

determining whether the first file is an incorrect version, wherein the determining whether the first file is the incorrect version further comprises determining whether a second file later in the classpath from the first file is an earlier version than the first file; and

if the first file is the incorrect version, issuing a warning.

5. An apparatus comprising:

means for finding a first class in a first directory specified in a classpath;

means for finding a second class in a second directory, wherein the second directory is later in the classpath than the first directory; and

means for determining whether the second class is a newer version of the first class.

REJECTIONS

Claims 5-8 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Ans. 3-5).

Claims 1 and 3-20 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement. (Ans. 5-6).

Claims 1, 3, 4, and 17-20 stand rejected under 35 U.S.C. § 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.. (Ans. 6-7).

GROUPING OF CLAIMS

(1) Appellants argue the rejection of claims 5-8 under 35 U.S.C. § 101 as a group (App. Br. 23-24). We select independent claim 5 as the representative claim. We will, therefore, treat claims 6-8 as standing or falling with representative claim 5.

(2) Appellants argue the rejection of claims 1 and 3-20 under 35 U.S.C. § 112 first paragraph as a group (*id.* at 24-28). We select independent claim 1 as the representative claim. We will, therefore, treat claims 3-20 as standing or falling with representative claim 1.

(3) Appellants argue the rejection of claims 1, 3, and 4 under

35 U.S.C. § 112 second paragraph as a group on the basis of claim 1 (*id.* at 28). We accept independent claim 1 as the representative claim. We will, therefore, treat claims 3 and 4 as standing or falling with representative claim 1.

(4) Appellants argue the rejection of claims 17-20 under 35 U.S.C. § 112 second paragraph as a group (*id.* at 28-29). We select independent claim 17 as the representative claim. We will, therefore, treat claims 18-20 as standing or falling with representative claim 17.

(5) Appellants argument with respect to the 35 U.S.C. § 112 second paragraph rejection of claims 6-9, 11, and 14-16 (Br. 29) is moot in view of the Examiner's statement in the Answer (Ans. 3) that although the rejection was withdrawn in the Final Rejection, it was erroneously entered as being maintained in the same action. We will, therefore, disregard this rejection.

We accept Appellants' grouping of the claims. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE 1

35 U.S.C. § 101: claims 5-8

Appellants argue that their invention is not directed to non-statutory subject matter since the "means plus function" recitation may be interpreted to read on only the structures or materials disclosed in the Specification and their equivalents (App. Br. 23-24).

In response, the Examiner maintains that claims 5-8 are directed to non-statutory subject matter because they recite an "apparatus" comprising a series of means that can be reasonably interpreted as software, *per se.*"

(Ans. 4). Since the invention can be realized entirely as software, the Examiner concludes the invention as recited in claims 5-8 are directed to non-statutory subject matter (Ans. 4 and 5).

Issue 1: Has the Examiner erred in finding that claims 5-8 are directed to non-statutory subject matter?

ANALYSIS

We sustain the Examiner's § 101 rejection of representative claim 5.

Appellants' argument that the "means for" elements recited have structure or materials is unpersuasive (Br. 24). Appellants do not specifically indicate the structure that corresponds to the recited "means" (*See e.g.*, Br. 7, 8, and 24). Appellants' employing of means-plus-function language "must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc). It is "consistently required that the structure disclosed in the specification be more than simply a general purpose computer or microprocessor." *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008).

Appellants do not specifically point out in the Specification the structure on which Appellants rely upon as disclosing each of the "means." Instead, Appellants relies upon a portion of the Specification that does not recite structure except for a memory (Br. 24) (*See also*, Spec. 10, ll. 21-23).

We conclude the cited portion does not correspond to either “means for finding” or the “means for determining.”

Moreover, we agree with the Examiner’s findings that Appellants’ invention has been disclosed as being a transmission signal in one embodiment (Ans. 8). Nominal recitations of structure, such as non-limiting preamble recitations, are insufficient to bring a claim within the scope of statutory subject matter. *Cf. Ex parte Langemyr*, 89 USPQ2d 1988, 1996 (BPAI 2008) (informative).

A claim that recites no more than software, logic, or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Additionally, signals are unpatentable under § 101. *In re Nuijten*, 500 F.3d 1346, 1355 (Fed. Cir. 2007). According to U.S. Patent & Trademark Office (USPTO) guidelines:

A claim that covers both statutory and non-statutory embodiments . . . embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter. . . . For example, a claim to a computer readable medium that can be a compact disc or *a carrier wave* covers a non-statutory embodiment and therefore should be rejected under § 101 as being directed to non-statutory subject matter (underline omitted).

U.S. Patent & Trademark Office, *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 2009, at 2, available at http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf (“Interim Instructions”).

The broadest reasonable interpretation of a claim drawn to a computer readable medium . . . typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. . . .

When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

David J. Kappos, *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010) (“OG Notice”), available at http://www.jenner.com/files/tbl_s20Publications/RelatedDocumentsPDFs1252/3066/PTO_Notice%201351%20OG%20212.pdf.

Claim 5 recites an apparatus comprising means for finding and means for determining. Aside from the nominal preamble recitation of “an apparatus,” we conclude that claim 5 considered as a whole is directed to determining whether a first file is an “incorrect version” and if so, issuing a warning – an invention which we conclude is abstract. *See Ex parte Gutta*, 93 USPQ2d 1025, 1032-33 (BPAI 2009) (precedential) (holding that system claim 14 including a memory and processor that otherwise recited an abstract idea failed to recite statutory subject matter under § 101).

Therefore, Appellants have not shown the Examiner erred in concluding the invention as recited in claims 5-8 are directed toward non-statutory subject matter. Accordingly, Appellants have not shown that the Examiner erred in rejecting claims 5-8 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

ISSUE 2

35 U.S.C. § 112, first paragraph: claims 1, 3-20

Appellants assert that their invention does not fail the enablement requirement of § 112, first paragraph (Br. 24-28). Specifically, Appellants contend that the invention is adequately described in the Specification to enable one of ordinary skill to make and use the invention (*id.*). Specifically,

Appellants assert that the term “incorrect” and how a file is determined to be “incorrect” or not and the term “older” or “newer” and how a file is determined to be “older” or “newer” is fully defined in the specification (*id.*).

Appellants also contend that the Specification adequately describes the steps necessary to acquire and display “exemplary” user interfaces and that the implementation is well known to persons of ordinary skill in the art (Br. 26 and 27). Further, Appellants argue file and class ownership are well known to persons of ordinary skill in the art (Br. 27).

The Examiner concludes that the claims do not enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention (Ans. 5, 6 and 9-13). The Examiner states that Appellants’ Specification does not adequately define what is meant by (i) the terms “incorrect”, “older”, or “newer” in the context of the recited determining steps or how a determination may be made as to whether a particular file or class may be determined to be “incorrect,” “older,” or “newer” or (ii) how a determination may be made as to whether such a user “owns” the first/second file/class. (*id.*). Further, the Examiner determines that while the specification illustrates “exemplary” user interfaces, the Specification provides no description reciting the necessary steps to acquire and display such information (*id.*).

Issue 2 : Have Appellants shown the Examiner erred in finding that the claims are not sufficiently described in the Specification in such a way to enable one of ordinary skill in the art to make and/or use the invention?

ANALYSIS

We disagree with the Examiner's findings and conclusions (Ans. 9-13). We conclude that despite the lack of specific criteria disclosed, one of ordinary skill in the art would have possessed the skills to determine if one classpath was "newer," "older," or "earlier." The Specification provides embodiments which although described at a higher level, would be within an ordinary artisan's skill to make and use the claimed invention without undue experimentation. We further conclude one of ordinary skill in the art at the time the invention was made would have possessed the skills necessary to determine if a class is "owned" by a user, although the specific criteria is not provided in either the Specification or in the claim.

The enablement requirement of § 112 demands that the patent specification enable those skilled in the art to make and use the full scope of the claimed invention without undue experimentation. *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 166 F.3d 1190, 1195 (Fed. Cir. 1999).

As a result, Appellants have shown the Examiner erred in concluding claims 1 and 3-20 are non-enabling. Accordingly, Appellants have shown the Examiner erred in rejecting claims 1 and 3-20 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement of the statute.

ISSUE 3

35 U.S.C. § 112, second paragraph: claims 1, 3, 4

Appellants assert their invention is not indefinite under 35 U.S.C. § 112, second paragraph (Br. 28). Specifically, Appellants contend that the

Examiner's allegation of indefiniteness is unwarranted because claim 1 recites a limitation that defines the term "incorrect" (*id.*). Additionally, Appellants argue their Specification recites what the classpath controller determines and provides a standard for ascertaining the requisite degree; thereof, one of ordinary skill in the art would be reasonably apprised of the scope of the invention (*id.*).

The Examiner finds that

[t]he term "incorrect" in claims 1-4 is a relative term which renders the claim indefinite. The term "incorrect version" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

(Ans. 6).

Issue 3: Has the Examiner erred in concluding claims 1, 3, and 4 are indefinite within the meaning of 35 U.S.C. § 112, second paragraph?

FINDINGS OF FACT

Appellants' Specification

1. An embodiment of Appellants' invention generally relates to detecting incorrect versions of files (Spec. 1, ll. 6-8).
2. A classpath may become a dumping ground for every conceivable directory and archive file. Therefore, the class may contain duplicate class entries. The user then may have great difficulty in determining which class (file) the class loader will load first. In an embodiment, the user may find the old and new versions

using a classpath (Spec. 3, ll. 9-17; Spec. 3, ll. 26-28; Spec. 4, l. 22 to Spec. 5, l. 2).

3. Appellants indicate that Figs. 5A and 5B are example processing according to an embodiment of the invention and that other embodiments may be utilized (Spec. 4, ll. 15-18; Spec. 12, ll. 21-22; and Spec. 14, ll. 17-27).

ANALYSIS

We agree with the Examiner's findings and conclusion. The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). This meaning is sufficiently clear to apprise an artisan of ordinary skill of the claim scope with sufficient precision and particularity. *See Moore*, 439 F.2d 1232, 1235 (Fed. Cir. 1971).

We conclude that the term "incorrect" is indefinite as an artisan of ordinary skill in the art would not have been apprised of the claim scope with sufficient precision and particularity. Appellants have not described in either the Specification of the claim, taken as a whole, the criteria used to determine if a file is an incorrect version. Appellants' invention is used to detect an incorrect file (FF 1). Appellants point to Figs. 5A and 5B as support for their argument (Br. 28); however, Figs. 5A and 5B are example processing according to an embodiment (FF 3). And according to these Figures, "incorrect" may mean whether the class is "owned" by a specific user, a "newer" version, or both (*See e.g.*, Figs. 5A and 5B). Moreover,

since this is one embodiment, it is not clear that other criteria cannot be used to determine if a file is “incorrect.”

Further, Appellants’ own claim indicates that determining whether a first file is the incorrect version *comprises* determining if a second file is an earlier version than the first file (Appd’x, claim 1). Thus, the use of the open ended “comprises” only bolsters the Examiner’s finding that the scope of the determination of whether a file is incorrect does not preclude additional elements or steps.² As a result, determining if a file is “incorrect” does not mean determining if a file is earlier than another. Therefore, the scope of the term “incorrect” is not defined with sufficient precision and particularity to allow an artisan of ordinary skill in the art to understand what is claimed.

It follows that Appellants have not shown the Examiner erred in finding claims 1, 3, and 4 are indefinite. Accordingly, Appellants have not shown the Examiner erred in rejecting claims 1, 3, and 4 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

ISSUE 4

35 U.S.C. § 112, second paragraph: claims 17-20

Appellants assert their invention not indefinite under § 112, first paragraph because “appellant is using [the word] ‘configuring’ with[in the

² See *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”) (citation omitted).

context of] the ordinary dictionary meaning, which is well known to persons of ordinary skill in the art” (App. Br. 28-29).

The Examiner concludes that “it is unclear what (if any) concrete acts are required by the various ‘configuring’ steps recited in [] claims [17-20]. The specification appears to describe ‘configuring’/ ‘configuration(s)’ only in the context of generic hardware arrangements and processing architectures” (Ans. 6-7).

Issue 4: Has the Examiner erred in concluding that claims 17-20 are indefinite within the meaning of 35 U.S.C. § 112, second paragraph?

ANALYSIS

We agree with the Examiner that the Specification does not describe or suggest how a computer is configured (Ans. 14 and 15). Indeed, we conclude an artisan of ordinary skilled in the relevant art would not understand what is claimed when the claim is read in light of the Specification. Appellants merely recite what may be broadly construed as programming a computer to perform functions without providing some detail about how to achieve the functions of “finding,” “determining,” or “issuing.” We therefore cannot determine the metes and bounds of the respective claims. As a result, Appellants have not shown the Examiner erred in finding claims 17-20 are indefinite. Accordingly, Appellants have not shown the Examiner erred in rejecting claims 17-20 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

DECISION

The Examiner's rejection of claims 5-8 under 35 U.S.C. § 101 as being directed to non-statutory matter is affirmed.

The Examiner's rejection of claims 1 and 3-20 under 35 U.S.C. § 112, first paragraph for lack of enablement is reversed.

The Examiner's rejection of claims 1, 3, 4, and 17-20 under 35 U.S.C. § 112, second paragraph as being indefinite is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED-IN-PART

Vsh

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